



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,548	09/25/2003	Peter Groz	HSJ920030143US2	5489

42640 7590 12/14/2005

DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

EXAMINER

TON, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2138

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,548

Applicant(s)

GROZ, PETER

Examiner

David Ton

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/03</u> . | 6) <input type="checkbox"/> Other: ____. |

1. The first paragraph on page 1 of the specification (paragraph [0001]) is objected to because the serial number and filing date of co-related application are missing.
2. Claims 1-20 are presented for examination.

Double Patenting

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and 8 may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. patent application S/N: 10/670,547. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the scope of the claimed subject matter in claims 1-20 of the instant application (claimed a computer program product) is broader than the scope of the claimed subject matter in claims 1-20 of U.S. patent application S/N: 10/670,547 (claimed a method).

Claims Objection

5. Claims 1 and 20 are objected to because the preamble is not clearly describe the invention (may have the 35 U.S.C. § 101 problem). The Examiner suggest the Applicant amend the preamble of claims 1 and 20 to change the word "**usable**" to "**readable**" as:

"A computer program product in a computer **readable** medium for ...".

Claim Rejections - 35 USC ' 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-20 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Yu et al. (Yu) patent no. 6,263,303, in view of Ackerman et al. (Ackerman) patent no. 5,146,460.

8. As to claim 1, Yu teaches the invention substantially as claimed, including a computer program product in a computer usable medium [claim 13] for performing testing of a simulated device [digital hardware system, col. 1 lines 4-6] in a testing simulation environment [col. 1 lines 9-20], said method comprising:

providing a software representation [module 16 of Fig. 2] of a plurality of hardware components within said simulated direct access storage device [see Fig. 7A];

providing a control program module [core 18 of Fig. 2] within said testing simulation environment, wherein said control program module interacts with said software representation of said plurality of hardware components [see claim 35];

providing a testing program [see program flowchart of Fig. 5D] for interacting with said control program module and said software representation of said plurality of hardware components;

in response to detection of an occurrence of a pre-selected event [event triggered 100 of Fig. 5C] within said simulated direct access storage device, sending [see EVENT(2) of Fig. 2] one or more codes [claim 31] from said testing program to said software representation of said plurality of hardware components [see claim 3]; and

determining whether or not a response by said control program module to said one or more codes is correct [col. 3 lines 10-13].

However, Yu does not explicitly teach the simulated device is a simulated direct access storage device.

However, a direct access storage device is a well known component in a digital hardware system such as the direct access storage 80 of Fig. 2B disclosed by Ackerman [col. 7 lines 36-47].

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to apply the behavior simulation for simulating a digital hardware system taught by Yu for simulation a simulated direct access storage device as taught by Ackerman. This modification would have been obvious and a person having ordinary skill in the art would have been motivated to do so because it would enhance the application of Yu invention.

9. As to claim 2, Yu teaches the hardware component comprises a microprocessor [col. 1 lines 9-20].
10. As to claims 3-4, Ackerman teaches codes represent software error event [software simulation of an error condition, col. 3 lines 31-38].
11. As to claim 5, Yu teaches the testing program is a behavior simulation program [col. Col. 1 lines 20-37].
12. As to claim 6, Yu teaches codes comprise one or more predefined stimuli [see claim 16].
13. As to claim 7, Yu teaches the testing program simulates the hardware components processing the codes in real-time [see claim 25].
14. As to claim 8, Yu teaches the control program-under-development [col. 1 lines 9-20].
15. As to claims 9-10, Yu teaches one or more code target one or more elements of the control program module and hardware components [claim 41].
16. As to claim 11, Yu teaches the pre-selected event return a value [see elements 128-130 of Fig. 5D].
17. As to claim 12, Yu teaches the pre-selected event comprises a memory register [memory device of claim 22].
18. As to claim 13, Yu teaches sending comprises writing a value to a memory register in the component [step 130 of Fig. 5D].

19. As to claim 14, Ackerman teaches recording the response [element 18 of Fig. 1A and claim 1].

20. As to claim 15, Ackerman teaches codes are stored in a testing event data structure in detail file 80 of Fig. 2B [the script file is well known in the art for running a segment executable program, see patent no. 6,106,298 or 6,208,955 cited on PTO 892].

21. As to claim 16, Ackerman teaches reporting the response [inherently in "create the necessary detailed trace information required for problem analysis" on col. 1 lines 8-21].

22. As to claim 17, Yu teaches pre-selected event includes the passage of a predefined length of time [delay stimulus of claim 22].

23. As to claim 18, Ackerman teaches a return value not matching a predefined value [see COMPARISON MISMATCH of Fig. 2A].

24. As to claim 19, Yu teaches the pre-selected event comprises the control program module executing a pre-selected instruction [see fig. 5D].

25. As to claim 20, it is a combination of claims 1-19 above; therefore, it is rejected under the same rationale.


Conclusion

26. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Ton whose telephone number is (571) 272-3828. The examiner can normally be reached on M-Th from 5:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Ton
Primary Examiner
Art Unit 2138